

REMARKS

Applicant thanks Examiner Lewis for the courtesy extended during the interview held 30 August 2004 by telephone. During this interview, applicant demonstrated an embodiment of the invention located at www.gogopatent.com. US Patent 5,623,681 (Rivette et al.) was also discussed.

The Examiner has rejected claims 1 - 47 as either being anticipated by Rivette et al. (5,623,681) or unpatentable over Rivette et al. (5,623,681) in view of Arthurs (6,591,261). Applicant respectfully disagrees with the Examiner for the following reasons.

Rivette et al. (5,623,681) discloses methods for synchronizing text, such as ASCII text, with an image of that text so that an end user can search the text and be able to cite where in the image the text came from. For example, Rivette et al. discuss synchronizing United States Patent text files with corresponding images so that the end user can cite the proper column and line number which appears in the image of the patent but not in the ASCII text of the patent. This is accomplished by entering patent numbers into a Unix system database (Rivette et al. column 11, lines 4-15). The system then locates the image and the text on respective separate tapes (see column 10, lines 50 - 51; column 13, lines 1-33) and saves this data to the "staging machine." Once the text and image data for each patent have been saved at the staging machine, it sends the text and image files to the

"pagination machine" on a DOS based machine. The pagination machine creates the synchronized text and image files to create an "Equivalent File" (see column 14, line 10; column 16, lines 10 - 68) which is next indexed on a DOS machine. Finally, a "manufacturing machine" creates a CD-ROM image of the "Equivalent Files" and burns same to a CD-ROM, whereupon the CD-ROM is sent to an end user who may read and utilize the patent text using special software that can read and manipulate the "Equivalent Files" (see column 19, line 54 et seq). Rivette et al. then disclose use of the software to create a "Library" (column 21, line 52, for example), search, annotate, highlight and otherwise utilize the Equivalent Files.

Applicant notes the complexity of the Rivette et al. method and apparatus which is in contrast to the instant claimed invention, the latter which emphasizes streamlined methods (see for example, page 9, lines 16 - 27 of this specification). Rivette et al. require several tiers of machines to access, associate, synchronize, paginate, burn to CD-ROM, and finally utilize the desired text/images. Rivette et al. disclose at least Unix and DOS machines in the preferred embodiment. The Rivette et al. method and apparatus also requires verification by a human to finalize the "Equivalent File" (see column 10, lines 15 - 18). Human intervention is cumbersome, error-prone and expensive, which is also in contrast to the instant invention (see for example, this specification at page 3, lines 11 - 15). Furthermore, since the end user employs Equivalent Files from a CD-ROM, there is no contemplation of web-based client/server request and delivery in Rivette et al. The CD-ROM medium obviates the need for any networking functionality and teaches away from a web-based e-commerce type of interface, the latter which is emphasized in the

instant invention (see for example, page 5, lines 1 - 3; page 6, lines 26 - 32 of this specification). Furthermore, Rivette et al. was filed in 1993, which is before the world wide web existed widely. The preferred embodiment of the instant invention is web-based e-commerce and largely non-analogous to the disclosure of Rivette et al.

With regard to specific claims, Rivette does not "receive a text request comprising a unique identifier and unformatted text" as required by claims 1 - 8; nor does Rivette disclose "receiving a request comprising a unique identifier and data" as required by claims 9 - 21 and 35 - 47; nor "receiving a unique identifier and unformatted data" as required by claims 22 - 34. This is shown, for example, at Rivette et al. column 11, line 4 which states:

"Continuing to refer to FIG. 1, when an order 10 requesting a list of patents is entered into a UNIX database 11, the UNIX database 11 sorts the request list by patent location to minimize the number of different tapes that need to be mounted, and sends to the staging machine 8 the list of patents and other pertinent information such as the volume serial number of the tapes, and location information that allows the staging machine 8 to fast forward to the individual patent files that are requested. The staging machine 8 creates a file on its disks of all the text and image portions of each patent that has been requested to process. When the staging machine 8 has the text and image files available, it sends the text and image files to the pagination machine 13." (underlining added)

Rivette et al. do not give any information as to the format "order 10" must take to effectively request desired patents. Rivette et al. do not state that "order 10" contains any unformatted text in addition to unique identifiers (unique identifiers, for example, being patent numbers). The advantage of the claimed invention is that the user need not "clean-up" or otherwise format in a particular way the request made. See, for example Figures 4 and 6 of this specification. In this example, a user wants to obtain all the patent documents cited in an email message. To obtain the documents, all the user needs to do is

copy and paste the entire email message into a browser area, and the user's data entry is done. The order is processed by computer software, which parses the email message and identifies the patent numbers (unique identifiers) and ignores the "unformatted text" or other "data" sent in the request. This software can execute on the server or client depending on the specific implementation desired (see this specification at page 14, lines 22 - page 15, line 4). Rivette's silence as to the format of "order 10" cannot permit anticipation of the instant claims. Most likely, as is generally known in the database art, "order 10" must have a very specific format, or the request will fail. Rivette's method and apparatus could not handle the email example discussed above and disclosed in the instant specification. Another request that Rivette will fail to handle and the instant invention will handle is the input of the entire text of a patent into the browser request area. Rivette's "order 10" could not take the form of an entire patent text because Unix database 11 would not know what to do with data that is not a patent number. In contrast, the claimed invention permits a user to obtain every patent cited within an entire patent simply by pasting the text of the patent into the browser request area.

Applicant respectfully disagrees with the Examiner that column 12, line 61 - column 14 of Rivette et al. disclose "unformatted text" or "unformatted data" according to the claimed invention. Rather, column 12, line 61 - column 14 of Rivette et al. describe data stored on magnetic tape, the data being specially formatted into patent file data. There is nothing "unformatted" about the data on the magnetic tapes. Furthermore, these passages do not describe a "text request" which is received by the browser request area. In claim 1, for example, the "receiving" of the "text request" can be performed by pasting into a

browser request area. It appears that the Examiner has interpreted the step of "receiving a text request" to be a user receiving the results of a request, rather than a computer with browser receiving a text request. To clarify, a user would "send" a request (not claimed) and the computer/browser "receives a request" (as claimed).

Applicant respectfully disagrees with the Examiner that Rivette teaches querying a user to order the identified file. The purpose of "querying a user to order the identified file" is to check whether or not the user wants to go ahead and purchase the identified file (see for example, Figure 7). During this querying step, the user can choose to purchase some, all or none of the selected files. Nowhere in Rivette is "querying a user" according to the claimed invention disclosed. Indeed, the opposite happens in Rivette, where the user queries the text to search for a keyword during utilization of the search, annotation, highlighting features of the Rivette software.

Applicant respectfully disagrees with the Examiner that Rivette teaches a "client computer" in Figure 1 or elsewhere in the disclosure. There is no discussion in Rivette of client computers or server computers, or the networking of the two to perform requests and responses. To employ the method and apparatus disclosed in Rivette one does not even need a network because CD-ROMs are manufactured and then sent to the end user through non-electronic, non-network means. Rivette's Figure 1 depicts the manufacturing process beginning from tape at 1 and ending with "MANUFACTURING" of the CD-ROM at 23. There is no indication in Rivette Figure 1 of network protocols or connections from clients to servers as instantly claimed.

Applicant respectfully disagrees with the Examiner that Rivette teaches the subject matter of claims 16, 29 and 42 which recite "wherein the item is a service." The only items disclosed by Rivette et al. are CD-ROMs containing text synchronized with images.

Applicant respectfully disagrees with the Examiner that Rivette teaches that "the request comprises an image." As discussed above, Rivette's "order 10" would fail if it contained an image or anything other than a patent number. In contrast, the instant invention contemplates and claims requests containing unformatted text, images, in addition to unique identifiers. This specification at page 15, line 30 - page 16, line 1 describes some example contents of the claimed requests.

Applicant respectfully disagrees with the Examiner that the subject matter of claims 5, 13, 21, 26, 34, 39 and 47 are disclosed or even contemplated by Rivette et al. Rivette's "order 10" which is entered into a Unix database, cannot take the form of an image. Furthermore, Rivette et al. do not mention browser windows.

With Respect to claims 8, 19, 32, 35, 44 and 45, Applicant disagrees with the Examiner that these claims are unpatentable over Rivette et al. in view of Arthurs. As the Examiner indicates in the office action dated June 2004, Rivette does not expressly teach a server computer. The Examiner relies on Arthurs to teach server computers and Java applets, however Applicant disagrees that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Rivette and Arthurs for the following

reasons. Rivette et al. was filed in 1993, before web browsers were widely available (see for example, <http://www.blooberry.com/indexdot/history/browsers.htm>). Furthermore, server computers and browsers before 1994 did not have the same ability for "interactivity" as those of today. In 1993, there was no such thing as e-commerce. Arthurs (6,591,261) was filed in 2000, with a priority claim to 1999. The six intervening years between the filing dates of these patents speaks to the nonobviousness of their combination. Rivette et al. could not have been aware in 1993 of the teachings of Arthurs which occurred in 1999, and therefore there can be no motivation to combine, because Rivette never expresses a need, desire or ability to incorporate server computers. Indeed, as mentioned above, Rivette teaches away from server/client systems because Rivette emphasizes manufacturing of CD-ROMs which are then mailed to users. With respect to Java applets of claim 45, Arthurs does not teach or suggest Java applets or similar. Therefore, there is not a *prima facie* showing of unpatentability of claim 45.

CONCLUSION

For the reasons set forth above, claims 1 - 47 are patentable over the prior art of relied upon. Applicant requests withdrawal of the rejections and issuance of claims 1 - 47.

Respectfully submitted,
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